

REMARKS

Applicant thanks Examiner Lewis for the courtesy extended during the interview held 23 March 2005 by telephone. During this interview, applicant demonstrated an embodiment of the invention located at www.gogopatent.com. The Hitchcock reference was also discussed. Applicant pointed out the differences between the pending claims and the Hitchcock reference.

The Examiner has rejected claims 1 - 47 as being anticipated by Hitchcock under 35 USC 102(e). Applicant respectfully disagrees with the Examiner for the following reasons.

The Hitchcock reference relied upon in the 27 December 2004 office action, entitled "Patent Searching Made Easy" 2nd Edition, was revised in March of 2001, according the copyright page. Therefore, this reference does not qualify as prior art under 35 USC 102(e) since it was published after applicant's filing date of 21 November 2000. For the same reasons, the Hitchcock reference would not qualify as prior art under 35 USC 102(a) nor 35 USC 102(b). Applicant requests that the Examiner withdraw the rejections made over the Hitchcock reference.

The Hitchcock reference is a manual or textbook published by Nolo. It is clear that the Hitchcock reference is not an "application for patent", published under section 122(b), by another filed in the United States before the invention by the applicant for patent" as

described in 35 USC 102(e). It is also clear that the Hitchcock reference is not "a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent...." as described in 35 USC 102(e). Therefore, for these additional reasons, the Hitchcock reference does not qualify as prior art under 35 USC 102(e). Applicant requests that the Examiner withdraw the rejections made over the Hitchcock reference.

For purposes of argument only, if the Hitchcock reference did qualify as prior art, Hitchcock would not anticipate claims 1 - 47 for the following reasons. These reasons are given herein only to further prosecution and provide a complete response, and should not be construed as an acquiescence that Hitchcock qualifies as prior art.

With regard to all pending claims, Hitchcock does not teach "a text request comprising a unique identifier and unformatted text" as required by claims 1 - 8; nor does Hitchcock teach "a request comprising a unique identifier and data" as required by claims 9 - 21 and 35 - 47; nor "a unique identifier and unformatted data" as required by claims 22 - 34. This is shown, for example, at Hitchcock page 3/ 7 at figure 10, which illustrates the specific formatting required for a search. Hitchcock shows that a specific syntax is required to search the disclosed database, wherein keywords are separated by Boolean operators. Elsewhere in Hitchcock, is shown other required search syntaxes such as "ttl/fire AND ttl/protection." To reiterate, specific syntax required to search the disclosed database fails to anticipate the claim elements of "unformatted text" and "unformatted data."

The advantage of the claimed invention is that the user need not format in a particular way the request made, much unlike Hitchcock. An embodiment of the claimed invention is described, for example, in Figures 4 and 6 of this specification. In this example, a user wants to obtain all the patent documents cited in an email message. To obtain the documents, all the user needs to do is copy and paste the entire email message into a browser area, and the user's data entry is done. The order is processed by computer software, which parses the email message and identifies the patent numbers (unique identifiers) and ignores the "unformatted text," "unformatted data" or other "data" sent in the request. This software can execute on the server or client depending on the specific implementation desired (see this specification at page 14, lines 22 - page 15, line 4). Hitchcock's reliance on special search syntax cannot permit anticipation of the instant claims.

As is generally known in the database art, searches must have a very specific format or syntax, or the request will fail. Hitchcock's examples could not handle the email example discussed above and disclosed in the instant specification. If a user were to paste the request shown in Figure 6 of this specification into the search box of Hitchcock's Figure 10 (page 3/ 7), the search would fail. Another request that Hitchcock will fail to handle and the instant invention will handle is the input of the entire text of a patent into the browser request area. Hitchcock's keyword search could not take the form of an entire patent text because the underlying database would not handle the unstructured format of the request, let alone the size of the request. In contrast, the claimed invention permits a

user to obtain every patent cited within an entire patent simply by pasting the text of the patent into the browser request area.

Applicant respectfully disagrees with the Examiner that the citations on page 3 of the 27 December 2004 office action (approximately lines 14-18) disclose "unformatted text" or "unformatted data" according to the claimed invention. Rather, these cites in Hitchcock describe specially formatted keyword searches with required syntax. There is nothing "unformatted" about a required syntax.

In further regard to all pending claims, Hitchcock does not teach a request comprising "a unique identifier" as required by all pending claims. Hitchcock teaches keyword searching. Keywords, by nature, identify many electronic files/documents that contain one or more keywords. Therefore, a keyword is not a "unique identifier." To the contrary, a keyword could be considered the opposite of a unique identifier because items identified using a keyword share the existence of that keyword and have not been uniquely identified by that keyword. An example of a unique identifier would be a patent number because a patent number uniquely identifies a patent.

Further along these lines, the Hitchcock reference does not teach, "parsing the request to identify the unique identifier" as required by all instant claims. For example, in an embodiment illustrated in this specification at figure 7, the request (shown in figure 4) has been parsed and the unique identifiers (in the example, patent numbers) were identified and presented to the user in figure 7. There is no comparative example in

Hitchcock, nor any other disclosure of "parsing the request to identify the unique identifier." What Hitchcock does do in terms of parsing is to search a database with keywords and present a hit-list to the user. Since the original request in Hitchcock (for example, figure 10) does not contain unique identifiers, the resultant hit-list is not a result of parsing and identifying the unique identifiers (as claimed).

Regarding dependent claims, all dependant claims are novel over Hitchcock for the reasons stated above and for the following additional reasons.

Regarding claims 4, 12, 25 and 38, applicant disagrees that Hitchcock teaches delivery as a bundle. Hitchcock, rather, teaches individual ordering as described on page 4/ 9.

Regarding claims 7, 31 and 18, Hitchcock does not teach execution on a client computer. Hitchcock is silent as to whether execution occurs on a server or client computer. Silence cannot be construed as anticipation. Furthermore, the database searching described by Hitchcock must be performed on a server computer.

Regarding claim 34, Hitchcock does not teach that the request comprises an image. The only searching disclosed by Hitchcock is by keyword. There is no disclosure in Hitchcock of inputting an image. Applicant respectfully disagrees with the Examiner that Hitchcock teaches that "the request comprises an image." Hitchcock would fail if a search contained an image or anything other than text or keywords.


Regarding claim 44, Hitchcock does not teach Java applets. Java applets can execute on a client computer. There is no disclosure in Hitchcock of client-side execution nor disclosure of client-side executables.

From a broad perspective, one advantage of the instant invention is to overcome the difficulties in obtaining copies of patent documents (see specification page 3, lines 22 - 23 and page 9, lines 16 - 19). Hitchcock highlights the awkwardness of obtaining patent documents on page 4/ 9. In Hitchcock, after performing keyword searching and figuring out which patents a user wants to obtain, the user must then click on each link and fill out a form for each desired patent; or the user can call a document delivery service to obtain hard copies. Note that electronic delivery (such as downloading) is not offered.

CONCLUSION

For the reasons set forth above, claims 1 - 47 are believed patentable. Applicant requests withdrawal of all rejections and issuance of claims 1 - 47.

Respectfully submitted,
Amy Atzel
708 N 1st Street, Suite 431
Minneapolis, MN 55401
(612) 692-8863



Amy Atzel
Applicant pro se

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